



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,508	04/09/2001	Jack G. Winterowd	WEYE117204	6724

26389 7590 06/27/2002

CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC  
1420 FIFTH AVENUE  
SUITE 2800  
SEATTLE, WA 98101-2347

EXAMINER

SHOSHO, CALLIE E

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 06/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/829,508

Applicant(s)

WINTEROWD, JACK G.

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

~~A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.~~

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 August 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 29 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-30 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action, for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

---

DETAILED ACTION

*Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-28, drawn to water-based paint composition, classified in class 524, subclass 561.
  - II. Claims 29-30, drawn to method of labeling an oriented strandboard panel bundle, classified in class 427, subclass 282.
2. The inventions are distinct, each from the other because:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process for using the product as claimed can be practiced with another materially different product such as oil-based paint. Further, the product as claimed can be used in a materially different process of using the product such as painting house interior or exterior using brush or roller.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and have acquired a separate

~~status in the art because of their recognized divergent subject matter, restriction for examination~~  
purposes as indicated is proper.

4. During a telephone conversation with George Renzoni on 6/18/02 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-28. Affirmation of this election must be made by applicant in replying to this Office action. Claims 29-30 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

#### **Double Patenting**

#### **Statutory Double Patenting**

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

---

6. Claims 24 and 26-27 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 24 and 26-27 of copending Application No. 09/943,885. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The present claims and the claims of 09/943,885 disclose the same invention given that both disclose water-based paint composition which comprises opacifying agent which is titanium dioxide, viscosity enhancing agent which is hydroxyethylcellulose, surfactant which is a salt derived from morpholine and long-chain carboxylic acid, polymeric binding agent which is an acrylic latex, and debonding agent active on metal surface comprising soybean oil wherein the paint exhibits no sedimentation formation or phase separation for about at least two months when stored at 20 °C.

#### **Non-Statutory Double Patenting**

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

~~provided the conflicting application or patent is shown to be commonly owned with this~~

application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-5, 7-23, and 28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-3, 7-23, and 28 of copending Application No. 09/943,885 in view of Nonweiler et al. (U.S. 5,700,522). Although the conflicting claims are not identical, they are not patentably distinct for the following reasons:

Prior to describing the rejection, it is noted that 09/943,885 is a continuation-in-part of the present application and thus, the claims of 09/943,885 overlap the present claims to a significant extent.

The difference between the claims of 09/943,885 and the present claims is the requirement in the present claims of (i) viscosity enhancing agent and (ii) spreadable rate of the paint.

With respect to difference (i), it is noted that claim 2 of 09/943,885 disclose that in addition to opacifying agent, binding agent, and debonding agent, the paint further comprises at least one of several listed additional ingredients wherein the ingredients include viscosity enhancing agent, however, the use of viscosity enhancing agent is not required.

---

Nonweiler et al., which is drawn to paint composition, disclose the use of viscosity enhancing agent such as hydroxyethylcellulose in order to impart desired rheology and viscosity to the paint (col.5, lines 17-29).

In light above, it therefore would have been obvious to one of ordinary skill in the art to use viscosity enhancing agent in paint of 09/943,885 in order to produce paint with viscosity suitable for its end use, and thereby arrive at the claimed invention.

With respect to difference (ii), it is noted that 09/943,885 disclose that the paint has spreadable rate of 10-300 g/m<sup>2</sup> while the present claims require that the paint has spreadable rate of 50-300 g/m<sup>2</sup>.

However, "in the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art", a *prima facie* case of obviousness exists", *In re Wortheim*, 541 F.2d 257, 191 USPQ 90 (CPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Feds. Cir. 1990).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to arrive at the present invention from the copending one.

This is a provisional obviousness-type double patenting rejection.

### **Claim Rejections - 35 USC § 102**

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

---

10. Claims 1-7, 10, and 14-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Romano (U.S. 5,510,409).

Romano discloses water-based paint comprising 40-60% water, 15-25% binder which is a latex such as polyacrylic acid, 15-25% titanium dioxide, vegetable oil such as soybean or rapeseed oil, fumed silica, and 1-5% of each of thickener such as carboxymethylcellulose, dispersant, defoamer, preservative, coalescing agent, and surfactant (col.1, lines 45-65, col.2, lines 6-10 and 27-30, col.2, line 64-col.3, line 21, and col.3, line 21). It is well known that polyacrylic acid has glass transition temperature of 106 °C.

Although there is no explicit disclosure that the composition exhibits no sediment formation or phase separation when stored at 2 months at 20 °C or any disclosure of the spreadable rate of the paint, given that Romano disclose paint identical to that presently claimed, it is clear that the paint of Romano would inherently exhibit no sedimentation formation or phase separation and would inherently possess spreading rate as presently claimed.

In light of the above, it is clear that Romano anticipates the present claims.

11. Claims 1-7, 14, and 16-23 rejected under 35 U.S.C. 102(b) as being anticipated by Bier (U.S. 4,792,357).

Bier discloses water-based paint comprising 1-10% hydroxyethylcellulose or carboxymethylcellulose, up to 20% titanium dioxide, up to 20% acrylic binder, up to 15% silicone oil, up to 2% surfactant, up to 5% colloidal, i.e. fumed, silica, up to 5% anti-foaming agent, and preservative (col.1, lines 8-9, col.3, lines 50, 53-56, and 61-63, col.4, lines 19-20 and 54-56, col.5, lines 5, 21-22, 27-28, and 37-42).



~~Although there is no explicit disclosure that the composition exhibits no sediment~~  
formation or phase separation when stored at 2 months at 20 °C or any disclosure of the spreadable rate of the paint, given that Bier disclose paint identical to that presently claimed, it is clear that the paint of Bier would inherently exhibit no sedimentation formation or phase separation and would inherently possess spreading rate as presently claimed.

In light of the above, it is clear that Bier anticipates the present claims.

12. Claims 1-5, 7, and 14-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Coleman (U.S. 3,959,224).

Coleman disclose water-based paint comprising latex, i.e. binder, obtained from alkyl (meth)acrylates, titanium dioxide, 0.1-1% surfactant, thickening agent such as hydroxyethylcellulose, dispersant, plasticizer, preservative, vegetable such as soybean oil, and defoamer (col.18, lines 53-55, col.19, lines 9-10 and 26, col.19, line 67-col.20, line 5, col.20, lines 9-10, 14-15, and 20-21, 25-26, and 31, and Table I). From Table I, it is calculated from Paint A, that the paint contains approximately 7.6% hydroxyethylcellulose and 20% titanium oxide.

Although there is no explicit disclosure that the composition exhibits no sediment formation or phase separation when stored at 2 months at 20 °C or any disclosure of the spreadable rate of the paint, given that Coleman disclose paint identical to that presently claimed, it is clear that the paint of Coleman would inherently exhibit no sedimentation formation or phase separation and would inherently possess spreading rate as presently claimed.

In light of the above, it is clear that Coleman anticipates the present claims.

---

**Claim Rejections - 35 USC § 103**

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

15. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Romano (U.S. 5,510,409), Bier (U.S. 4,792,357), or Coleman (U.S. 3,959,224) any of which in view of Gruenwald (U.S. 2,374,678).

The disclosures with respect to Romano, Bier, and Coleman in paragraphs 10, 11, and 12, respectively, are incorporated here by reference.

The difference between Romano, Bier, or Coleman and the present claimed invention is the requirement in the claims of specific type of surfactant.

Romano, Bier, and Coleman each disclose use of surfactant, however, there is no disclosure of specific type of surfactant as presently claimed.

~~Gruenwald disclose surfactant which is derived from morpholine and long-chain, i.e. C<sub>12</sub>-~~

C<sub>36</sub>, carboxylic acid (page 1, col.1, lines 35-45) wherein the motivation for using such surfactant is that it is inexpensive, imparts enhanced surface-active properties, and produces better pigment dispersions (page 1, col.1, lines 15-21 and page 2, col.2, lines 9-15).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use such surfactant in the paint of Romano, Bier, or Coleman in order to produce a paint with superior surfactant properties and effective pigment dispersion, and thereby arrive at the claimed invention.

16. Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bier (U.S. 4,792,357) or Coleman (U.S. 3,959,224) either of which in view of Schall et al. (U.S. 6,013,721).

The disclosures with respect to Bier and Coleman in paragraphs 11 and 12, respectively, are incorporated here by reference.

The difference between Bier or Coleman and the present claimed invention is the requirement in the claims of specific type of binder.

Schall et al., which is drawn to water-based paint, disclose the use of binder with glass transition temperature of 10-40 °C such as butyl acrylate/methyl methacrylate copolymer (col.4, lines 8-11 and 56-59). Although there is no explicit disclosure of the pH of the binder, given that the binder is identical to that presently claimed, it is clear that it would inherently possess the same pH. The motivation for using such binder is to control the adhesion of paint to substrate.

~~In light of the above, it therefore would have been obvious to one of ordinary skill in the~~  
art to use specific binder disclosed by Schall et al. in paint of either Bier or Coleman in order to produce paint that effectively adheres to substrate, and thereby arrive at the claimed invention.

17. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Romano (U.S. 5,510,409) in view of Schall et al. (U.S. 6,013,721).

The disclosure with respect to Romano in paragraph 10 above is incorporated here by reference.

The difference between Romano and the present claimed invention is the requirement in the claims of specific type of binder.

Schall et al., which is drawn to water-based paint, disclose the use of binder with glass transition temperature of 10-40 °C such as butyl acrylate/methyl methacrylate copolymer (col.4, lines 8-11 and 56-59). Although there is no explicit disclosure of the pH of the binder, given that the binder is identical to that presently claimed, it is clear that it would inherently possess the same pH. The motivation for using such binder is to control the adhesion of paint to substrate.

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use specific binder disclosed by Schall et al. in paint of Romano in order to produce paint that effectively adheres to substrate, and thereby arrive at the claimed invention.

18. Claims 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Romano (U.S. 5,510,409) in view of Gruenwald (U.S. 2,374,678) and Nonweiler et al. (U.S. 5,700,522).

---

Romano discloses water-based paint comprising 40-60% water, 15-25% binder which is a latex such as polyacrylic acid, 15-25% titanium dioxide, vegetable oil such as soybean or rapeseed oil, fumed silica, and 1-5% of each of thickener such as carboxymethylcellulose, dispersant, defoamer, preservative, coalescing agent, and surfactant (col.1, lines 45-65, col.2, lines 6-10 and 27-30, col.2, line 64-col.3, line 21, and col.3, line 21). Although there is no explicit disclosure that the composition exhibits no sediment formation or phase separation when stored at 2 months at 20 °C or any disclosure of the spreadable rate of the paint, given that Romano disclose paint identical to that presently claimed, it is clear that the paint of Romano would intrinsically exhibit no sedimentation formation or phase separation and would intrinsically possess spreading rate as presently claimed.

The difference between Romano and the present claimed invention is the requirement in the claims of (a) specific type of surfactant and (b) specific type of viscosity enhancing agent.

With respect to difference (a), Romano discloses use of surfactant, however, there is no disclosure of specific type of surfactant as presently claimed.

Gruenwald disclose surfactant which is derived from morpholine and long-chain, i.e. C<sub>12</sub>-C<sub>36</sub>, carboxylic acid (page 1, col.1, lines 35-45) wherein the motivation for using such surfactant is that it is inexpensive, imparts enhanced surface-active properties, and produces better pigment dispersions (page 1, col.1, lines 15-21 and page 2, col.2, lines 9-15).

With respect to difference (b), Romano discloses the use of thickener such as carboxymethylcellulose, but there is no disclosure of hydroxyethylcellulose as presently claimed.

~~Nonweiler et al., which is drawn to paint composition,~~ disclose the use of thickeners such as hydroxyethylcellulose in order to control the rheology and viscosity of the paint (col.5, lines 18-29).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use such surfactant and thickener in the paint of Romano in order to produce paint with superior surfactant properties and effective pigment dispersion as well as paint with viscosity suitable for its end use, and thereby arrive at the claimed invention.

19. Claims 24 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bier (U.S. 4,792,357) in view of Gruenwald (U.S. 2,374,678).

Bier discloses water-based paint comprising 1-10% hydroxyethylcellulose or carboxymethylcellulose, up to 20% titanium dioxide, up to 20% acrylic binder, up to 15% silicone oil, up to 2% surfactant, up to 5% colloidal, i.e. fumed, silica, up to 5% anti-foaming agent, and preservative (col.1, lines 8-9, col.3, lines 50, 53-56, and 61-63, col.4, lines 19-20 and 54-56, col.5, lines 5, 21-22, 27-28, and 37-42). Although there is no explicit disclosure that the composition exhibits no sediment formation or phase separation when stored at 2 months at 20 °C or any disclosure of the spreadable rate of the paint, given that Bier disclose paint identical to that presently claimed, it is clear that the paint of Bier would intrinsically exhibit no sedimentation formation or phase separation and would intrinsically possess spreading rate as presently claimed.

The difference between Bier and the present claimed invention is the requirement in the claims of specific type of surfactant.

~~Bier discloses use of surfactant, however, there is no disclosure of specific type of~~  
surfactant as presently claimed.

Gruenwald disclose surfactant which is derived from morpholine and long-chain, i.e. C<sub>12</sub>-C<sub>36</sub>, carboxylic acid (page 1, col.1, lines 35-45) wherein the motivation for using such surfactant is that it is inexpensive, imparts enhanced surface-active properties, and produces better pigment dispersions (page 1, col.1, lines 15-21 and page 2, col.2, lines 9-15).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use such surfactant in the paint of Bier in order to produce a paint with superior surfactant properties and effective pigment dispersion, and thereby arrive at the claimed invention.

20. Claims 24 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman (U.S. 3,959,224) in view of Gruenwald (U.S. 2,374,678).

Coleman disclose water-based paint comprising latex, i.e. binder, obtained from alkyl (meth)acrylates, titanium dioxide, 0.1-1% surfactant, thickening agent such as hydroxyethylcellulose, dispersant, plasticizer, preservative, vegetable such as soybean oil, and defoamer (col.18, lines 53-55, col.19, lines 9-10 and 26, col.19, line 67-col.20, line 5, col.20, lines 9-10, 14-15, and 20-21, 25-26, and 31, and Table I). Although there is no explicit disclosure that the composition exhibits no sediment formation or phase separation when stored at 2 months at 20 °C or any disclosure of the spreadable rate of the paint, given that Coleman disclose paint identical to that presently claimed, it is clear that the paint of Coleman would intrinsically exhibit no sedimentation formation or phase separation and would intrinsically possess spreading rate as presently claimed.

~~The difference between Coleman and the present claimed invention is the requirement in~~  
the claims of specific type of surfactant.

Coleman discloses use of surfactant, however, there is no disclosure of specific type of surfactant as presently claimed.

Gruenwald disclose surfactant which is derived from morpholine and long-chain, i.e. C<sub>12</sub>-C<sub>36</sub>, carboxylic acid (page 1, col.1, lines 35-45) wherein the motivation for using such surfactant is that it is inexpensive, imparts enhanced surface-active properties, and produces better pigment dispersions (page 1, col.1, lines 15-21 and page 2, col.2, lines 9-15).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use such surfactant in the paint of Coleman in order to produce a paint with superior surfactant properties and effective pigment dispersion, and thereby arrive at the claimed invention.

21. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman in view of Gruenwald as applied to claims 24 and 26-28 above, and further in view of Nonweiler et al. (U.S. 5,700,522).

The difference between Coleman in view of Gruenwald and the present claimed invention is the requirement in the claims of coalescing agent.

Nonweiler et al., which is drawn to paint composition, disclose the use of coalescing agent to promote more continuous coating (col.5, line 59-col.6, line 5).

In light of the motivation for using coalescing agent disclosed by Nonweiler et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use



Art Unit: 1714

such coalescing agent in the paint of Coleman in order to produce a paint which form a continuous film, and thereby arrive at the claimed invention.

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kramer et al. (U.S. 6,069,189) disclose paint comprising binder, soybean oil, titanium oxide, and preservative, however, the paint is not water-based as presently claimed.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

CS.

Callie Shosho  
6/22/02

EDWARD J. CAIN  
PRIMARY EXAMINER  
GROUP 1500

